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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,624	01/17/2001	Alan L. Everett	29627.0006	5312

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EXAMINER

KIM, CHRISTOPHER S

ART UNIT	PAPER NUMBER
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3752

DATE MAILED: 06/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,624

Applicant(s)

EVERETT, ALAN L.

Examiner

Christopher S. Kim

Art Unit

3752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-12 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 6, 2003 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Claims 1, 3-5, 9-11 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Richter (5,765,730).

Richter discloses a dispensing tip comprising: a body (section B and downstream thereof); an inlet (inlet to section B); an outlet 37; a fluid conducting passage 35; a first portion B; a second portion (between B and outlet 37); zirconia ceramic material (column 6, line 37). The recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. The recitation of

Art Unit: 3752

“injection molded” has been considered a produce by process limitation. MPEP 2113 states:

“[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)....

The functional recitation “such that the diameter of a drop of viscous fluid leaving the outlet is directly proportional to the ratio of the axial length of the second portion to the axial length of the first portion” appears to describe a condition of operation and only requires the ability to so perform. Additionally, the claims do not define the axial length of the first and second portions. Therefore, any arbitrary length of Richter’s first and second axial lengths can be defined to meet applicant’s limitation.

Claim Rejections - 35 USC § 103

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tomasello (4,622,714).

Tomasello discloses a dispensing tip comprising: a body 16, 18; an inlet 14; an outlet 20; a fluid conducting passage (passage through 16 and 18); a first portion 16a, 16b; a second portion 18. The recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from

Art Unit: 3752

a prior art apparatus satisfying the claimed structural limitations. The working fluid of Tomasello is air rather than viscous fluid. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have used the device of Tomasello to dispense viscous fluid for its low divergence and high efficiency (column 4, lines 38-41).

The functional recitation "such that the diameter of a drop of viscous fluid leaving the outlet is directly proportional to the ratio of the axial length of the second portion to the axial length of the first portion" appears to describe a condition of operation and only requires the ability to so perform. Additionally, the claims do not define the axial length of the first and second portions. Therefore, any arbitrary length of Tomasello's first and second axial lengths can be defined to meet applicant's limitation.

5. Claims 1, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heron et al. (4,878,785) in view of Vickers (4,342,425).

With respect to claim 1, Heron et al. discloses a dispensing tip comprising: a body (having sections 3, 5, 6); an inlet (inlet to section 5); an outlet 6; a fluid conducting passage 3, 5; a first portion 3; a second portion 5. The recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

Heron et al. does not disclose the working fluid being a viscous fluid. It would have been obvious to a person having ordinary skill in the art at the time of the invention

Art Unit: 3752

to have used the device of Heron et al. to dispense viscous fluid for its low wear characteristics (column 1, lines 7-8).

The functional recitation "such that the diameter of a drop of viscous fluid leaving the outlet is directly proportional to the ratio of the axial length of the second portion to the axial length of the first portion" appears to describe a condition of operation and only requires the ability to so perform. Additionally, the claims do not define the axial length of the first and second portions. Therefore, any arbitrary length of Heron's first and second axial lengths can be defined to meet applicant's limitation.

With respect to claims 6 and 7, Heron et al. discloses the limitations of the claimed invention with the exception of a protective housing including a standoff. Vickers discloses a housing 106 and a standoff 108. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have incorporated the housing and standoff of Vickers to the device of Heron et al. to enable positioning of the device.

6. Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richter (5,765,730).

Richter discloses the limitations of the claimed invention with the exception of the second portion/outlet diameter range. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a second portion/outlet having a diameter of about 0.003 inch to about 0.030 inch to enable dispensing of fine quantities, since it has been held that where the general conditions of

Art Unit: 3752

a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

7. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richter (5,765,730) in view of Vickers (4,342,425).

Richter discloses the limitations of the claimed invention with the exception of a protective housing including a standoff. Vickers discloses a housing 106 and a standoff 108. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have incorporated the housing and standoff of Vickers to the device of Richter to enable positioning of the device.

Response to Arguments

8. Applicant's arguments filed May 6, 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that Richter's inlet is defined by reference sign 31, reference sign indicates the inlet to the device as shown in figure 3 but the section defined by B must have an inlet since fluid flows to and through section B.

Applicant comments that claim 1 has been amended to recite the diameter of drop of viscous fluid to the diameter of the outlet. No structural limitation is recited for the diameter of the outlet. Rather, the recitation appears to describe a condition of operation and only requires the ability to so perform. Additionally, the claims do not define the axial length of the first and second portions. Therefore, any arbitrary length

Art Unit: 3752

of the first and second axial lengths in the prior art can be interpreted to meet applicant's limitation.

Applicant comments that claim 9 recites a monolithic body. A single layer in the body of Ritcher is monolithic.

Applicant's argument that Ritcher is non-analogous art is improper for a rejection under 35 USC 102.

In response to applicant's argument that Tomasello does not disclose a precision dispensing tip as claimed, "precision" is a relative term. The specification does not define or limit the term. The term has been considered to define breadth rather than being indefinite. Additionally, applicant fails to identify how Tomasello fails to meet the precision dispensing tip as claimed.

In response to applicant's argument that Tomasello is non-analogous art, Tomasello differs from the claimed invention with respect its use. The recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

In response to applicant's argument that Haron et al. does not disclose a passage portion converging in a direction immediately from the inlet, Haron et al. discloses a passage portion 3, 5 converging in a direction (section 5 converges in a downstream direction) immediately from the inlet (inlet to section 5).


Conclusion

Art Unit: 3752

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. Kim whose telephone number is (703) 308-8336. The examiner can normally be reached on Monday - Thursday, 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Y. Mar can be reached on (703) 308-2087. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Christopher S. Kim
Examiner
Art Unit 3752

CK
June 26, 2003